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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,733	07/21/2003	Brian T. Kobashikawa	08226/1201530-US1	7188
38880	7590	07/24/2006	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 5257 NEW YORK, NY 10150-6257			LIN, SHEW FEN	
			ART UNIT	PAPER NUMBER
			2166	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/624,733	<b>Applicant(s)</b> KOBASHIKAWA ET AL.	
	<b>Examiner</b> Shew-Fen Lin	<b>Art Unit</b> 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

- a. This action is responsive to amendment filed on 4/21/2006.
- b. Claims 1-29 are pending and new claims 21-29 have been added. Claims 1, 9, 16, 18, 21, and 28 are independent claims.

### ***Withdrawal of Rejections/Objections***

Applicants' amendments, submitted on 4/21/2006, overcome the 101 rejection and claim objections. Examiner hereby withdraws the rejection/objections that were given in the previous Office Action.

### ***Response to Amendment and Remarks***

Applicant's amendments and remarks have been fully and carefully considered but are moot in view of new/old grounds of rejection. In response to these amendments, upon further search the Examiner has found the prior art reference of Tafoya et al. (US Patent 6,952,805), in combining with Harms et al. (US Publish 2003/0078981), Creswell et al. (US Patent 6,564,264) teach "based on a different application associated with each of the at least one archive", "over a network", and "comprising a list of e-mail addresses generated with a first/second application. Refer to the corresponding sections of the claim analysis for details.

Regarding Applicant's arguments in page 10 that Harms does not teach or suggest "accessing, over a network, an electronic archive comprising a list of e-mail address generated with a first application" because Harms's system scans for messages in an e-mail inbox of message residing on a local database", "information from the message in database or storage

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device is retrieved”, and “database or memory structure associated with the portable device”.

The Examiner respectfully disagrees.

First, the database described by Harms in paragraph [0031] (“Contact list stored in a database or memory structure associated with the portable device”), is the database of “Contact list” not “message database”.

Second, Harm discloses receiving incoming message through a network (Figure 1, network 110, paragraph [0014]). Therefore, Harms teaches “accessing, over a network, an electronic archive comprising a list of e-mail address generated with a first application”.

Third, Harms discloses a method and apparatus “message in a database or storage device are scanned or reviewed” (paragraph [0029], lines 3-4). Harms also discloses that device 100 communicates with network 110. Using network to access the database is inherent in the prior art. Person with ordinary skill in the art will know how to use network to access database in a server or other computers in the network. Therefore, “over a network” is inherently taught in the prior art, the claim limitations are anticipated based on the inherent function.

Please also note that the header of the Remark Pages (2-8), “Application No. 10/790,332”, is irrelevant to the instance Application, 10/624,733.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Harms et al. (US Publish 2003/0078981, hereinafter referred as Harms).

**As to claim 9**, Harms discloses a method for use in generating and maintaining an address book, comprising:

Accessing, over a network, an electronic archive comprising a list of e-mail addresses generated with a first application (monitor incoming message or scan message database, incoming message is received “over a network” and generated by sender application, Figures 1-3, paragraph [0031]);

Parsing the electronic archive for the e-mail addresses, based on the first application (retrieve e-mail address and/or name based on incoming message or database structure, Figures 2-3, paragraph [0026], lines 2-6);

applying a first criterion to a first retrieved e-mail address(check to see e-mail existing in contact list, Figure 2, paragraph [0037], lines 3-6); and

adding the first retrieved e-mail address to an electronic address book if the first criterion is met (add e-mail address automatically or after approval, paragraph [0027], paragraph [0031]).

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**As to claim 10**, Harms discloses the elements of claim 9 as noted above and further discloses wherein the applying includes applying a second criterion to the first retrieved address (filter address to include message from specified domains as second criterion, Figure 6, paragraph [0035], lines 11-16); and the adding includes adding the first retrieved address to the electronic address book if both the first and second criteria are met (new e-mail address comes from specified domain will be added, Figures 2 and 6, paragraph [0036]).

**As to claim 11**, Harms discloses the elements of claim 10 as noted above and further discloses supplying a plurality of criteria options (filter rules reads on criteria, Figure 6, paragraph [0026], lines 6-14, paragraph [0035], lines 1-5); and receiving a selection of criteria including the first and second criteria (criteria can be user defined and selected, paragraph [0021], lines 6-14).

**As to claim 12**, Harms discloses the elements of claim 10 as noted above and further discloses wherein the archive includes an archive of e-mails (message in database or storage device, Figure 3, paragraph [0030], lines 1-2); and the parsing includes parsing a plurality of fields associated with each e-mail of the archive (plurality of fields - "From Field", "To Field", and "CC Field", paragraph [0035], lines 5-11).

**As to claim 15**, Harms discloses the elements of claim 12 as noted above and further discloses generating a nickname in association with the first e-mail address (display name reads

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on nickname, abstract, lines 2-6); and adding the nickname associated with the first e-mail address to the address book (abstract, lines 6-8).

Claims 21-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tafoya et al. (US Patent 6,952,805, hereinafter referred as Tafoya).

**As to claim 21**, Tafoya discloses an apparatus for use in populating an electronic address book over a network (populating a resolution list over the network, resolution list contains contact information or email addresses and reads on “electronic address book”, column 2, lines 25-28), comprising: a transceiver in communication with the network (network interface or modem to communicate with network, Figure 1, items 158, 160, column 6, lines 35-41); a processor in communication with the transceiver (communicate through bus, Figure 1, items 102, 106, column 5, lines 39-43); and a memory in communication with the processor (Figure 1, items 104, 226, 128, 130), and storing processor executable instructions that cause the processor to perform a plurality of actions, including:

accessing, over the network, a plurality of archives of e-mails for an e-mail (Figure 2, items 210, 220, 230, column 6, lines 55-61);

parsing the e-mail to obtain an e-mail address based at least in part on an application associated with the e-mail (retrieve email address from data store, column 6, lines 61-67, column 7, lines 23-36);

adding the e-mail address to the electronic address book (add to resolution list when email address matches criteria, Figures 4C, 4D, item 440, column 12, lines 45-64); and

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providing to a user device, over the network, an access to the electronic address book (user can save or edit the list, column 2, lines 33-35).

**As to claim 22**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein adding the e-mail address to the electronic address book further comprises adding the e-mail address if the e-mail address occurs at a certain frequency (Figure 4B, items 416, 418, 420, column 12, lines 20-30) the e-mail address is similar to another e-mail address (Figure 4c, item 434), or a date associated with the e-mail address meets a threshold (column 8, lines 57-60).

**As to claim 23**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein the electronic address book is stored at least on one of the user device (column 2, lines 33-35), the apparatus, or another network device.

**As to claim 24**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein at least one of the plurality archives of e-mails is stored on the apparatus, the user device (database mail store located in local, column 7, lines 30-31), or another network device (Figure 2, items 210, 220, 230).

**As to claim 25**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein the parsing further comprises sending a parsing instruction to cause remote



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parsing of the e-mail on a network device which stores the plurality of archives of e-mails (access data store to extract email address, column 7, lines 23-36).

**As to claim 26**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein each of the plurality of archives of e-mails is associated with a different application (different version software, various contact database or other types of electronic files, column 7, lines 23-36).

**As to claim 27**, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein at least one of the plurality of archives of e-mails includes e-mails of different applications (different version software, various contact database or other types of electronic files, column 7, lines 23-36).

Claims 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Creswell et al. (US Patent 6,564,264, hereinafter referred as Creswell).

**As to claim 28**, Creswell discloses an apparatus for use in populating a destination electronic address book over a network (update a user address book couple to the network, Figure 1, column 3, lines 48-50), comprising: a transceiver in communication with the network; a processor in communication with the transceiver; and a memory in communication with the processor (connect and exchange information with network by any terminal device such as a PC,

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Figure 1, column 3, lines 23-35), and storing processor executable instructions that cause the processor to perform a plurality of actions, including:

- accessing a first source electronic address book for a first e-mail address, the first source electronic address book comprising a list of e-mail addresses generated with a first application (access address book for “send to” address, Figure 3, item 303, column 4, lines 44-47);

- evaluating the e-mail address based on a first defined criterion (check if address exist in the user’s data set, Figure 3, item 303, column 4, lines 47-52); and

- adding the e-mail address to the destination electronic address book if the first defined criterion is satisfied (Figure 3, item 305, column 4, lines 54-56).

**As to claim 29**, Creswell discloses the elements of claim 28 as noted above and further discloses wherein the actions further comprising:

- accessing a second source electronic address book for a second e-mail address, the second source electronic address book comprising a list of e-mail addresses generated with a second application (search other database, e.g. white pages or yellow pages supported by YAHOO or ALTA VISTA, Figure 3, item 313, column 3, lines 61-67);

- evaluating the second e-mail address based on the first defined criterion (find required email address, Figure 3, item 315); and

- adding the second e-mail address to the destination electronic address book if the first defined criterion is satisfied (Figure 3, item 319, column 5, lines 6-9).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8, 13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms in view of Tafuya.

**As to claims 1, 16, and 18**, Harms discloses a method/system/apparatus for use in populating an electronic address book (contact list reads on address book, paragraph [0021], lines 1-2), comprising:

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searching through at least one archive of e-mails for an e-mail address (search new message or messages in database, Figures 2-3, paragraph [0026], lines 2-6) based on a different application associated with each of the at least one archive;

evaluating the e-mail address based on a first defined criterion (find new e-mail address, Figures 2-3, paragraph [0037], lines 3-6, paragraph [0045], lines 2-4), ; and

adding the e-mail address to the electronic address book if the first defined criterion is satisfied (add e-mail address automatically or after approval, paragraph [0031]).

Harms does not explicitly disclose searching archive of e-mails associated with different application for an e-mail.

Tafoya discloses searching from multiple data sources such as sent or received email, and other types of electronic files such as word processor or spreadsheet files (Figure 2, items 210, 220, and 230, column 4, lines 24-34, column 6, lines 55-63). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms's disclosure to search different e-mail archive as taught by Creswell for the purpose of extracting e-mail address from different sources (Figure 3, item 307, Tafoya). The skilled artisan would have been motivated to improve the invention of Harms per the above such that address book can be populated by different servers/application (Figure 2, Tafoya).

**As to claims 2 and 17**, Harms discloses the elements of claim 1 as noted above and further discloses wherein the searching includes searching an "From" field, a "to" field and a "cc" field (Figure 6, paragraph [0035], lines 5-11).

**As to claim 3**, Harms discloses the elements of claim 1 as noted above and further discloses wherein the evaluating includes determining if the e-mail address already exists in the electronic address book, and not adding the e-mail address in the electronic address book if it already exists in the electronic address book (only select the address not in the contact list, paragraph [0037], lines 3-6).

**As to claims 4 and 19** Harms discloses the elements of claims 3 and 18 as noted above and further discloses wherein the evaluating includes evaluating the e-mail address based on a second defined criterion (include address from specified domains as second criterion, Figure 6, paragraph [0035], lines 11-16); and the adding includes adding the e-mail address to the electronic address book if both the first and the second defined criterion are satisfied (new e-mail address comes from specified domain will be added, Figures 2 and 6, paragraph [0036]) and not adding the e-mail address to the electronic address book unless both the first and second criteria are satisfied (existing e-mail address or not comes from specified domain will not be added, Figures 2 and 6, paragraph [0036]).

**As to claim 5**, Harms discloses the elements of claim 1 as noted above and further discloses determining if the at least one archive from which the e-mail address was retrieved includes an organization (database, paragraph [0025], lines 8-9); organizing the electronic address book according to at least a portion of the at least one archive from which the e-mail address was retrieved (organize based on last name, Figure 4); and the adding includes adding

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the e-mail such that the e-mail address is added according to the organized address book (Figure 4, paragraph [0027]).

**As to claim 6**, Harms discloses the elements of claim 1 as noted above and further discloses generating a retrieved list of e-mail addresses retrieved during the searching that satisfy the first defined criterion (new address is found, paragraph [0037], lines 3-6); and the adding includes adding the e-mail addresses if the e-mail address is confirmed to be added (Figure 4, paragraph [0031], paragraph [0033]).

**As to claim 8**, Harms discloses the elements of claim 6 as noted above and further discloses receiving confirmation of additions based on the retrieved list prior to the adding the e-mail address (select e-mail to enter from list of new address, Figure 4, paragraph [0027], paragraph [0033]).

**As to claim 13**, Harms discloses the elements of claim 10 as noted above and further discloses accessing, over the network, an external archive comprising a second list of e-mail addresses (paragraph [0030], lines 1-2 ) generated with a second application;

- parsing the external archive for e-mail addresses (Figure 3);
- retrieving e-mail addresses from the external archive (Figure 3, paragraph [0030]);
- applying the first and second criteria (filter address to include message from specified domains as second criterion, Figure 6, paragraph [0035], lines 11-16); and

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adding the retrieved e-mail addresses from the external archive if the retrieved e-mail addresses from the external archives meet both the first and second criteria (new e-mail address comes from specified domain will be added, Figures 2 and 6, paragraph [0036]).

Harms does not explicitly disclose searching archive of e-mails associated with a second application for an e-mail.

Tafoya discloses searching from multiple data sources such as sent or received email, and other types of electronic files such as word processor or spreadsheet files (Figure 2, items 210, 220, and 230, column 4, lines 24-34, column 6, lines 55-63). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms's disclosure to search different e-mail archive as taught by Creswell for the purpose of extracting e-mail address from different sources (Figure 3, item 307, Tafoya). The skilled artisan would have been motivated to improve the invention of Harms per the above such that address book can be populated by different servers/application (Figure 2, Tafoya).

**As to claim 20**, Harms discloses the elements of claim 19 as noted above and further discloses a code segment for supplying a plurality of criteria options (different filter rules can be applied, Figure 6, paragraph [0035]); and a code segment for receiving a selection of criteria including the first and second criteria (select criteria/rules from fields, domain, Figure 6, paragraph [0035]).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harms and Tafoya as applied to claim 1 above, and further in view of Creswell.

**As to claim 7**, Harms and Tafoya (Harms-Tafoya) discloses the elements of claim 1 as noted above but does not explicitly disclose generating a verification list of at least the e-mail address added to the address book

Creswell discloses verifying the user with message with the updated address information (Figures 2 and 3, column 2, lines 48-55, lines 63-64, column 4, lines 51-57).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms-Tafoya's disclosure to include verification of updated e-mail address as taught by Creswell for the purpose of confirmation of updated e-mail address (Figure 3, item 307, Creswell). The skilled artisan would have been motivated to improve the invention of Harms-Tafoya per the above such that added address book can be verified.

Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms as applied to claim 12 above, and further in view of Cortright et al. (US Patent 6,895,426, hereinafter referred as Cortright).

**As to claim 14**, Harms discloses the elements of claim 12 as noted above and further discloses

determining if the archive includes an organizational folder (database, paragraph [0025], lines 8-9);

the adding includes adding the first e-mail address to the electronic address book in the generated folder (Figure 4, paragraph [0027]).



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Harms does not explicitly disclose determining if the e-mail address was retrieved from the organization folder; generating a folder within the addresses book; and adding the first e-mail address to the electronic address book in the generated folder.

Cortright discloses determining if the e-mail address was retrieved from the organization folder (provide icon to identify where the e-mail address was retrieved; person, list, newsgroup, test, or address. Figures 4A/B, 5A/B, Figure 9, column 4, lines 44-67, column 8, lines 1-43). Cortright also discloses generating a folder within the addresses book and add e-mail address to the folder (column 10, lines 26-44, lines 55-61).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms's disclosure to identify the status /source of e-mail address as taught by Cortright for the purpose of providing appropriate icon for the use to manipulate the address (column 2, lines 57-67, column 3, lines 1-3, Cortright). The skilled artisan would have been motivated to improve the invention of Harms per the above such that address book can be updated without manual, time-consuming process (column 3, lines 4-8, Cortright).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Shew-Fen Lin  
Patent Examiner

Art Unit 2166  
July 20, 2006

  
MOHAMMAD ALI  
PRIMARY EXAMINER